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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,783	02/03/2000	Albert G. Lintel III	ZANS.10001NP	6688

7590

11/22/2002

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EXAMINER

KAPADIA, MILAN S

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 11/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/496,783

**Applicant(s)**

LINTEL III ET AL.

**Examiner**

Milan S Kapadia

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed 23 September 2002. Claims 17-24 are pending. Claims 1-16 have been canceled.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon et al (5,890,129) and further in view of Peterson et al. (6,343,271).

(A) As per claim 17, Spurgeon teaches a healthcare information system comprising:  
a plurality of provider office systems (Spurgeon; abstract and figure 1), each  
provider office system comprising:

circuitry for generating referral requests (Spurgeon; abstract);

referral authorization for:

receiving referral requests (Spurgeon; abstract),  
generating electronic authorization requests to an associated  
insurance company responsive to ones of said referral requests  
(Spurgeon; abstract),  
receiving an electronic authorizations/denial for each electronic  
authorization request (Spurgeon; abstract).

Spurgeon fails to expressly disclose forwarding denied authorization requests to a third party human researcher for further research. However, this feature is old and well known in the art as evidenced by Peterson's teachings with regards to forwarding denied authorization requests to a third party human researcher for further research (Peterson; col. 13, lines 23-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Spurgeon's system to forward denied authorization requests to a third party human researcher for further research, as taught by Peterson, with the motivation of enabling denied authorization requests to be processed further (Peterson; col. 2, lines 40-41).

(B) As per claim 18, Spurgeon fails to expressly disclose wherein said referral authorization circuitry further forwards referral requests that cannot be authorized electronically to a third party human researcher. However, this feature is old and well known in the art as evidenced by Peterson's teachings with regards to wherein said referral authorization circuitry further forwards referral requests that cannot be authorized electronically to a third party human researcher (Peterson; col. 10, line 50-

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col. 11, line 76). It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Spurgeon's system to forward referral requests that cannot be authorized electronically to a third party human researcher, as taught by Peterson, with the motivation of enabling a proposed request that is consistent with fraud, unintentional error, or for some other reasons to be reviewed more thoroughly (Peterson; col. 4, lines 35-42).

(C) As per claim 19, Spurgeon teaches a central information system having a global database of referral information in communication with said provider office systems (Spurgeon; col. 7, lines 8-27; the examiner interprets the "information-exchange system" as a "central information system.")

(D) As per claim 20, Spurgeon teaches wherein said global database is corrected responsive to a denial referral (Spurgeon; col. 10, line 65-col. 11, line 11).

(E) As per claim 21, Spurgeon teaches wherein said authorization requests are EDI messages (Spurgeon; col. 7, lines 8-27; the examiner interprets reformatting of data to be compatible with insurer or provider as a form of electronic interchange).

(F) Method claims 22-24 repeat the subject matter of system claims 17, 17 and 18, and 18, respectively, as a series of steps rather than a set of apparatus elements. As the underlying structure of claims 17 and 18 has been shown to be fully disclosed by the

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teachings of Spurgeon and Peterson in the above rejections of claims 17 and 18, it is readily apparent that the system disclosed by Spurgeon and Peterson include the steps to perform these functions. As such, these limitations are rejected for the same reasons given above for system claims 17 and 18, and incorporated herein.

### ***Response to Arguments***

2. Applicant's arguments with respect to newly added claims 17-24 have been considered but are moot in view of the new ground(s) of rejection.

(A) At pages 4 and 5 of the 9/23/02 communication, Applicant argues each of the applied references individually.

In response, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular, the teachings that Applicant argues are missing from the Spurgeon reference are clearly disclosed in the respective teachings of Peterson, when considered collectively with that of Spurgeon, as discussed in detail within a prior Office Action (paper number 2) and in the preceding rejections, and incorporated herein.

Further, the features newly added and entered in the amendment filed 7/10/02, they have been shown to be fully disclosed by or obvious in view of the collective

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teachings of Spurgeon and Peterson, as discussed above in detail within the preceding sections of the present Office Action.

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches an automated networked service request and fulfillment system and method (5,995,939).

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Thursday, 8:30 A.M. to 6:00 P.M. In addition the examiner can be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.




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November 18, 2002

  
DINH X. NGUYEN  
PRIMARY EXAMINER

## Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.